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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of : McMeekin *et al.*

Serial No. : 09/503,262 Group No. : 3751

Filed : 02/14/00 Examiner : David J. Walczak

For : Textured Film Devices

I, **Wendy A. Choi**, Registration No. **36,697**, certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

On February 15, 2002

Wendy A. Choi, Registration No. **36, 697**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This paper is filed in response to the Restriction Requirement in the above-identified application, mailed 01/18/02.

Claims 1-46 are pending in this application. The Examiner has required restriction under 35 U.S.C. § 121 between:

I. Claims 1-23, drawn to a textured film material, classified in class 15, subclass 209.1; and

II. Claims 24-46, drawn to a textured film used with an active material, classified in class 401, subclass 201.

The Examiner asserts that the inventions of Groups I and II are related as combination-subcombination. Applicants respectfully traverse.

At a minimum, applicants submit that the claims should be regrouped because they are not correctly characterized in the groupings set forth above. More particularly, claims 1-~~29~~ 28 and 40-46 are directed to a device and methods of using the device and claims ~~30~~ 29-39 are directed to a system containing the device and an active material.

Applicants respectfully submit that the restriction requirement between the claims of Groups I and II is improper because the Examiner has not established that the claimed inventions of each group are distinct. To show that the inventions are distinct, the Examiner must show:

(1) the invention does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness); and

(2) the subcombination can be shown to have utility either by itself or in other and different relations.

MPEP § 806.05(c).

In the instant application, the device of claim 1 is the "subcombination" or the part, and the system of claim 29 is the "combination" or the organization containing the part and at least a second element. Applicants concede that the subcombination – the device of claim 1 – has utility by itself or in other and different relations. However, applicants traverse that the invention does not require the particulars of the subcombination – the device of claim 1 – to establish the patentability of the combination – the system of claim 29 employing the device of claim 1. Thus, applicants submit that the inventions of Groups I and II are not distinct and, therefore, the restriction requirement is improper.

However, to be fully responsive to the restriction requirement, applicants will elect to prosecute the claims of Group I. Applicants respectfully request the Examiner, at a minimum, to reconsider the grouping of the claims and, further, to reconsider the very basis for the restriction itself. If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

Respectfully submitted,

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